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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Applicant: Toyoshima)	Art Unit: 2643
)	
Serial No.: 09/974,724)	Examiner: Vu
)	
Filed: October 9, 2001)	50P4257.04
)	
For: WIRELESS MODEM MODULE SERVER SYSTEM)	June 3, 2005
)	750 B STREET, Suite 3120
)	San Diego, CA 92101
)	

APPEAL BRIEF

Commissioner of Patents and Trademarks

Dear Sir:

This brief is submitted under 35 U.S.C. §134 and is in accordance with 37 C.F.R. Parts 1, 5, 10, 11, and 41, effective September 13, 2004 and published at 69 Fed. Reg. 155 (August 2004). This brief is further to Appellant's Notice of Appeal filed herewith.

Table of Contents

<u>Section</u>	<u>Title</u>	<u>Page</u>
(1)	Real Party in Interest.....	2
(2)	Related Appeals/Interferences.....	2
(3)	Status of Claims.....	2
(4)	Status of Amendments.....	2
(5)	Concise Explanation of Subject Matter in Each Independent Claim.	2
(6)	Grounds of Rejection to be Reviewed.....	3
(7)	Argument.....	3
App.A	Appealed Claims	
App.B	Evidence Appendix	06/06/2005 BRONHER 00000000 09974724
App.C	Related Proceedings Appendix	02 FC:1402 500.00 OP

1168-106.APP

CASE NO.: 50P4257.04

Serial No.: 09/974,724

June 3, 2005

Page 2

PATENT

Filed: October 9, 2001

(1) Real Party in Interest

The real party in interest is Sony Corp.

(2) Related Appeals/Interferences

Appeals have been filed in related application serial nos. 09/972,183 and 09/972,781.

(3) Status of Claims

Claims 1-3, 5-10, and 30 are pending and finally rejected, and the remaining claims have been canceled.

(4) Status of Amendments

An amendment canceling Claims 11-19 has been filed to place the application in condition for appeal.

(5) Concise Explanation of Subject Matter in Each Independent Claim, with Page and Figure Nos.

As an initial matter, it is noted that according to the Patent Office, the concise explanations under this section are for Board convenience, and do not supersede what the claims actually state, 69 Fed. Reg. 155 (August 2004), see page 49976. Accordingly, nothing in this Section should be construed as an estoppel that limits the actual claim language.

Claim 1 sets forth an apparatus for managing data for a wireless device (e.g., host unit 210, figure 3, page 6, lines 20-30) that includes a first memory for storing received data of a wireless device and a second memory for storing a network operational file (e.g., memories 160, figure 2, page 5, line 18). The

1168-106.APP

CASE NO.: 50P4257.04

Serial No.: 09/974,724

June 3, 2005

Page 3

PATENT

Filed: October 9, 2001

operational file includes instructions for selecting a destination using a wireless module (e.g., device 100, figures 2 and 3, pages 5 and 6) of the wireless device. Instruction means are provided for operating the network operational file for sending the received data using the wireless module to the selected destination (bottom of page 6 to page 7, line 3). The instruction means sends the received data via a wireless path to an email address associated with the selected destination, page 8, first full paragraph.

Claim 30 sets forth a digital camera system including a digital camera (e.g., one implementation of the host unit 210, page 7, lines 11-21) and a wireless transceiver (100, id.) coupled to the camera. A memory (id.) is provided for storing digital photographs from the camera. Data is automatically sent using the wireless transmitter to a remote location via a network router when an amount of data stored in the memory reaches a threshold, page 7, lines 22-27.

(6) Grounds of Rejection to be Reviewed on Appeal

(a) Claims 1-3 and 5-10 have been rejected under 35 U.S.C. §103 as being unpatentable over Zegelin et al. (USPN 6,694,430) combined with Lee et al. (USPN 6,728,531).

(b) Claim 30 has been rejected under 35 U.S.C. §103 as being obvious over Cook (USPN 6,788,332) in view of Lewis et al., USPN 5,294,792.

(7) Argument

As an initial matter, it is noted that according to the Patent Office, a new ground of rejection in an examiner's answer should be "rare", and should be levied only in response to such things as newly presented arguments by Applicant or to address a claim that the examiner previously failed to address, 69 Fed. Reg.

1168-106.APP

CASE NO.: 50P4257.04

Serial No.: 09/974,724

June 3, 2005

Page 4

PATENT

Filed: October 9, 2001

155 (August 2004), see, e.g., pages 49963 and 49980. Furthermore, a new ground of rejection must be approved by the Technology Center Director or designee and in any case must come accompanied with the initials of the conferees of the appeal conference, id., page 49979.

(a) The rejection of Claim 1 admits that the primary reference fails to teach an operational file that enables selection of a destination, and that it further fails to teach sending information to an email address associated with the selected destination - in other words, the primary reference fails to teach or suggest the heart of Claim 1. Appellant agrees that this deficiency exists in the prior art. Nonetheless, the missing requirements in Claim 1 including the recitation that the data is sent via a wireless path to an email address associated with the selected destination have been rejected because "it is inherently understood that the information transmissions to the server [in the secondary reference] include email transmissions".

This is legal error. First, inherency is a doctrine of anticipation, not obviousness. Second, to be "inherent", a feature must *necessarily* be part of the prior art, MPEP §2112; mere possibilities are insufficient. The relied-upon portions of the secondary reference (Lee et al.) in fact do not mention much less use email, demonstrating that the use of email is not "necessary" in Lee et al. as is otherwise required to support an inherency finding. Instead, in Lee et al. information from a vehicle is uploaded to an Internet gateway for later retrieval explicitly using a web browser, not email. Significantly, Lee et al. indeed is aware of email - it is one type of personal information that can be downloaded to the user from the Internet gateway - but nowhere does Lee et al. make the critical recognition which is reflected in Claim 1 that an email address may be the destination of data that is uploaded from the vehicle. Among other things, Lee et al. thus requires a browser to retrieve previously uploaded information, whereas a simple email-only device may be used to

1168-106.A.PP

CASE NO.: 50P4257.04
Serial No.: 09/974,724
June 3, 2005
Page 5

PATENT
Filed: October 9, 2001

retrieve information in the invention of Claim 1. Accordingly, a proper *prima facie* case of obviousness cannot be made based on the references applied against Claim 1.

(b) The rejection of Claim 30 likewise uses a primary reference (Cook) that admittedly fails to teach or suggest the gravamen of the claim being rejected, namely, uploading data from a camera when an amount of data reaches a threshold, relying on a secondary reference (Lewis et al.) for the making up the deficiency. However, the pen of Lewis et al. does not envision network use. Instead, it motivates the skilled artisan to cause an automatic download only to a host computer that is nearby the pen. For this reason, even if Lewis et al. were to be combined with Cook, Claim 30, which now requires a network router, would not result.

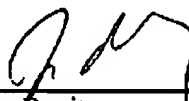
Additionally, Lewis et al. is not analogous to the digital camera art either of Claim 30 or to the primary reference with which it is sought to be combined. Specifically, it has not been shown using evidence of record where the prior art or general knowledge in the art indicates that the wireless digital camera artisan would logically have consulted the handwriting recognition art, as is otherwise required by MPEP §2136 to establish analogousness. The examiner has responded by correctly noting what the law says about analogousness, but then demonstrates an incapacity to apply it by noting that Cook and Lewis et al. are both directed to wireless devices without comprehending that neither Claim 30 nor Cook are directed to "wireless devices" in general but rather to digital cameras. This has lead the examiner into the error of casting far too broad a net in defining what the relevant subject matter is. Lewis et al. simply is not analagous to the art actually recited in Claim 30, which is digital cameras, not "wireless devices".

1168-106.A/PP

CASE NO.: 50P4257.04
Serial No.: 09/974,724
June 3, 2005
Page 6

PATENT
Filed: October 9, 2001

Respectfully submitted,



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1168-105.APP

CASE NO.: 50P4257.04
Serial No.: 09/974,724
June 3, 2005
Page 7

PATENT
Filed: October 9, 2001

APPENDIX A - APPEALED CLAIMS

1. An apparatus for managing data for a wireless device, comprising:
a first memory for storing received data of a wireless device;
a second memory for storing a network operational file, said operational file including instructions for selecting a destination using a wireless module of said wireless device, and
instruction means for operating the network operational file for sending the received data using the wireless module to the selected destination, wherein the instruction means sends the received data via a wireless path to an email address associated with the selected destination.
2. The apparatus of Claim 1, wherein the first and second memories are located on the wireless module.
3. The apparatus of Claim 1, wherein the network operational file can be configured for the wireless device and the selected destination.
5. The apparatus of Claim 1, wherein the instruction means can send the received data in real time to a selected destination.
6. The apparatus of Claim 1, wherein a host can send data via the wireless module to the wireless device.
7. The apparatus of Claim 6, wherein the host can send data in real time via the wireless module to the wireless device.
8. The apparatus of Claim 1, wherein the wireless device is a digital camera, PDA, laptop, MP3 player, or a wireless flash memory device.
9. The apparatus of Claim 1, wherein the wireless device is connectable to an ISDN, Cellular or DSP network.
10. The apparatus of Claim 1, wherein the wireless module is integrated into the wireless device.
30. A digital camera system, comprising:
a digital camera;
a wireless transceiver coupled to the camera; and
a memory for storing digital photographs from the camera, data being automatically sent using the wireless transmitter to a remote location via a network router when an amount of data stored in the memory reaches a threshold.

116A-106.A7P

CASE NO.: 50P4257.04
Serial No.: 09/974,724
June 3, 2005
Page 8

PATENT
Filed: October 9, 2001

APPENDIX B - EVIDENCE

None (this sheet made necessary by 69 Fed. Reg. 155 (August 2004), page 49978.)

1168-106.APP

CASE NO.: 50P4257.04
Serial No.: 09/974,724
June 3, 2005
Page 9

PATENT
Filed: October 9, 2001

APPENDIX C - RELATED PROCEEDINGS

None (this sheet made necessary by 69 Fed. Reg. 155 (August 2004), page 49978.)

1168-106 APP